

REMARKS

The Non-Final Office Action, mailed March 8, 2011 (“Office Action”) has been reviewed and the Examiner’s comments considered. Claims 1-60 are pending in this application. Claims 28-60 are withdrawn, and are canceled without prejudice or disclaimer by this amendment.

Statement on Substance of Interview

A Telephonic Interview was conducted on June 6, 2011 (“Interview”). Participating in the Interview were Examiner Andrew M. Gilbert and Lester J. Anderson, Reg. No.: 45,833. The rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 102 were discussed. With respect to the former, Examiner Gilbert agreed that energy for rotation is provided by the drag force, but requested that functionality of the blocking members and movement of the needle hub be clarified in the response. Clarification is provided below. With respect to the latter, distinctions between the claimed invention and cited art were discussed in the Interview, and are developed in more detail below.

Claim Rejections - 35 U.S.C. § 112

Claims 1-27 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action alleges that “[t]he specification does not describe how the drag force provides all of the energy for movement of the binding member.” (Office Action, p. 2.)

The Office Action states:

Here, the applicant’s specification discloses the ‘drag force in conjunction with one of the blocking members 116 and/or 117, cause binding member 105 to move into a binding position. The force created by blocking member 116 and/or 117 acts in a direction opposite the drag force. This causes a force couple, which moves the binding member 105 to the binding member 105 to the binding position. . . . The applicant has explicitly disclosed that the drag

force acts in conjunction with the blocking members 116 and/or 117 that create a force to move the binding member into a binding position. Thus, the drag force does not provide all of the energy.”

(Office Action, pp. 2-3, emphasis in original.)

As the Office Action points out, the blocking members act in conjunction with the drag force. The blocking members do not *provide* energy, however. The blocking members block movement of a portion of the binding member. This force is a redirection of energy supplied by the drag force. Referring to the figures of the Instant Application, the blocking members 116, 117 are not energy storage devices, e.g., springs. There is no energy *pre-stored* to provide the energy for rotation of the binding. Further, to any extent that the blocking members 116, 117 deform slightly and store a small amount of energy as the binding member 105 is pulled into them; this energy is still provided by the drag force. As the stylet 106 is pulled proximally, some amount of energy provided thereby is collected by the friction member 126. Accordingly, the drag force pulls on the blocking member at friction member 126. The binding member 105 contacts blocking member 116 generally near the location of the arrow of reference character 105 in FIG. 9. This blocks further motion of this portion of blocking member 105. No energy is provided by the blocking member itself. The drag force continues to act on friction member 126. This force couple causes rotational forces on the binding member. As the stylet 105 clears the stylet communicating surface 123 the binding member is then free to rotate.

The Office Action further states that “a user pulls the needle and needle hub proximally to cause the binding member to slide along the needle to cause the binding member to become in position to move into a binding position.” (Office Action, p. 3.) Applicants do not disagree. The Office Action further alleges, however, that “[t]his force by the user means the drag force does not provide all of the energy for rotation.” (Office Action, p. 3, emphasis in original.) Applicants respectfully disagree. The only way that energy from the movement of the needle acts to cause rotation is through the friction members. While it is true that energy is provided by a user pulling the needle hub, it is the friction with the frictional members from this movement that provides all of

the energy for rotation. Accordingly, the drag force providing all of the energy for rotation of the binding member.

As set forth in the July 22, 2010 response, the Instant Application indicates that all of the energy for rotation is derived from the drag force, as discussed in the following passage:

Friction members 126 are configured for slidable engagement with stylet 106 between the retracted position and the extended position such that friction members 126 engage stylet 106 to create a drag force with stylet 106. It is envisioned that one or a plurality of friction members 126 may be employed.

The drag force in conjunction with one of blocking members 116 and/or 117, cause binding member 105 to move to a binding position (FIG. 4). The force created by blocking members 116 and/or 117 acts in a direction opposite to the drag force. This causes a force couple, which moves binding member 105 to the binding position.

As stylet 106 is released from engagement with a stylet communicating surface 123, binding member 105 and a retainer 114 move to the binding position. Rotation of binding member 105 is no longer opposed by engagement with stylet 106 at stylet communicating surface 123. Thus, binding member 105, with retainer 114, is subject to inclination into the binding position. Rotation of binding member 105 causes binding surfaces 122 to frictionally engage stylet 106 to prevent movement thereof.

(Instant Application, p. 12, ll. 8-23, emphasis added).

Accordingly, the friction members 126 create the drag force. An equal and opposite force is

exerted by the blocking member(s) 116, 117 in accordance with Newton's third law of motion¹ to create the force couple.² These forces cause the binding member 105 to move to the binding position. (See, Instant Application, for example, FIG. 4.) Accordingly, the blocking members 116, 117 do not provide energy to the system, and therefore the drag force must provide all of the energy for movement of the binding member as it is the only source of energy in the system.

In view of the above, Applicants request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Claim Rejections - 35 U.S.C. § 102

Claims 1-13 and 15-27 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over USPN 5,697,907 to Gaba ("Gaba"). Claims 1-23, 25, and 27 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over USPN 7,226,434 to Carlyon et al. ("Carlyon"). Applicants respectfully traverse these rejections.

The Office Action fails to specifically point out which features of Gaba allegedly constitute several features of independent claim 1. Upon careful review of Gaba, Applicants are unable to locate at least the feature of "the drag force providing all of the energy for movement such that the drag force and a blocking member cause rotation of the binding member," as recited in independent claim 1. Gaba differently derives energy for rotation from a spring.

Accordingly, in view of the above, independent claim 1 is patentable over Gaba as Gaba does not show or describe each and every element. Dependent claims 2-13 and 15-27 are patentable

¹ Newton's third law of motion states that "[w]henver a first body exerts a force F on a second body, the second body exerts a force $-F$ on the first body. F and $-F$ are equal in magnitude and opposite in direction."

² A force couple (couple) is "a pair of equal, parallel forces acting in opposite directions and tending to produce rotation." Couple. Dictionary.com. *Dictionary.com Unabridged*. Random House, Inc. <http://dictionary.reference.com/browse/couple> (accessed: March 10, 2010).

at least because they depend from a patentable independent claim, and also because they recite features not shown or described by the cited art.

The Office Action also fails to specifically point out which features of Carlyon allegedly constitute several features of independent claim 1. Upon careful review of Carlyon, Applicants are unable to locate at least the feature of “the drag force providing all of the energy for movement such that the drag force and a blocking member cause rotation of the binding member,” as recited in independent claim 1. Carlyon differently derives energy for rotation from legs 32, 40 that “are biased for convergent movement.” (Carlyon, col. 7, l. 19.) In other words, the legs generate “spring forces.” (Carlyon, col. 7, l. 49.) It is these spring forces that cause the rotation.

In the binding orientation, needle cannula 22 passes out of aperture 34 and bearing surface 42 facilitates inclination of clip 28. As legs 32, 40 convergently bias, bearing surface 42 engages needle cannula 22 causing clip 28 to rotate, relative to longitudinal axis x, aperture 30 into the binding orientation with needle cannula 22. Bearing surface 42 also engages needle cannula 22 in the binding orientation to prevent movement of needle cannula 22 in the proximal and distal directions. This configuration advantageously locks distal end 26 of needle cannula 22 in a protected configuration without requiring any perturbations on the outer surface of the needle.

(Carlyon, col. 7, l. 52-63.)

Accordingly, in view of the above, independent claim 1 is patentable over Carlyon as Carlyon does not show or describe each and every element. Dependent claims 2-23, 25, and 27 are patentable at least because they depend from a patentable independent claim, and also because they recite features not shown or described by the cited art. Therefore, Applicants request favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 102.

Claim Rejections - 35 U.S.C. § 103

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaba in view of USPN 4,978,344 to Dombrowski et al. (hereinafter “Dombrowski”). Applicants respectfully traverse this rejection.

Without conceding the propriety of the asserted combination, or the assertions made in the Office Action with respect to the allegedly disclosed subject matter, Applicants submit that claim 14 depends from patentable independent claim 1, in view of the above, and is therefore patentable. Accordingly, Applicants request favorable reconsideration and withdrawal of this rejection under 35 U.S.C. § 103.

Double Patenting

Claims 1-27 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of USPN 7,179,244 (“the ‘244 patent”). Applicants respectfully traverse this rejection.

Applicants respectfully submit that instant claim 1 is patentably distinct from the patented independent claims. Claim 1 of the instant application recites that “the drag force providing all of the energy for movement such that the drag force and a blocking member cause rotation of the binding member” which is not present in the claims of the ‘244 patent. Accordingly, instant claims 1-27 are patentably distinct from patented claims 1-27 of the ‘244 patent. Applicants note that dominant claims (i.e., broad claims in the absence of statutory or non-statutory grounds) by themselves, as noted in the MPEP at § 804, are inappropriate to support an obviousness-type double patenting rejection.

Accordingly, the pending claims are distinct from those of the ‘244 patent for at least this reason, and Applicants request favorable reconsideration and withdrawal of the double patenting rejection.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicants of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-2191, under Order No. 101673.0057P4 from which the undersigned is authorized to draw.

Dated: June 8, 2011

Respectfully submitted,

Electronic signature: /Todd W. Wight/
Todd W. Wight
Registration No.: 45,218
RUTAN & TUCKER LLP
611 Anton Boulevard, Suite 1400
Costa Mesa, California 92626
(714) 641-5100
Patents@Rutan.com